

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLICATION NO. 10/032,617  
ATTORNEY DOCKET NO. Q67549

### **REMARKS**

Applicant thanks the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on March 26, 2003 and returning an initialed copy of the PTO/SB/08 A & B form, thereby confirming that the listed references have been considered.

Claims 1-74 have been examined on their merits.

Claims 1-74 are all the claims presently pending in the application.

1. Claim 22 stands rejected under 35 U.S.C. § 112 (1<sup>st</sup> para.) as allegedly failing to comply with the written description requirement. Applicant traverses the rejection of claim 22 for at least the reasons discussed below.

Original claims constitute their own description. *In re Koller*, 613 F.2d 819, 204 U.S.P.Q. 702 (CCPA 1980); MPEP §2163.03. Contrary to the Patent Office's assertion, a review of at least paragraph [0029] of the application reveals a detailed discussion of the claimed invention. The parameters for making a decision on which backup memory to select are recited in paragraph [0029]. Moreover, the phrases "priority determination," "sensitivity to failure determination," "space availability determination," and others are discussed in detail. Applicant submits that the explanation provided therein is sufficient for an artisan of ordinary skill to make

and use the invention. Thus, Applicant respectfully requests that the Patent Office withdraw the § 112 (1<sup>st</sup> para.) rejection of claim 22.

2. Claims 52 and 64 stand rejected under 35 U.S.C. § 112 (2<sup>nd</sup> para.) as allegedly being indefinite. Applicant traverses the rejection of claims 52 and 64 for at least the reasons discussed below.

Applicant herein amends claims 52 and 64, and submits that the § 112 (2<sup>nd</sup> para.) rejection of claims 52 and 64 has been overcome. Applicant respectfully requests withdrawal of the § 112 (2<sup>nd</sup> para.) rejection of claims 52 and 64.

3. Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Byrd (U.S. Patent No. 4,763,333). Applicant traverses the rejection of claims 1-4 for at least the following reasons.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). A proper anticipation rejection requires that every

element of the claim be found “in a single prior art reference.” *See In re Robertston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999). For anticipation to exist, there must be no difference between the claimed invention and the reference disclosure, as that reference would be understood by one of ordinary skill in the art. *See Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); *see also, Crown Operations Intn’l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

Applicant submits that Byrd fails to teach or suggest several features of the present invention recited in claim 1. The Patent Office draws equivalence between the read-only memory (ROM) of Byrd and a non-volatile memory recited in claim 1. It is well known in the art that a ROM is programmed at manufacturing and the programming remains unchanged. Therefore, Byrd’s ROM is unable to perform the functions recited in claim 1, *i.e.*, storing data in non-volatile memory. *See, e.g.*, paragraph [0015] of the instant application.

Moreover, Byrd’s system has other drawbacks. One drawback is that in a power failure that causes a failure in an uninterruptible power supply, data stored in Byrd’s system will be lost.

Furthermore, according to Byrd, normal operation of the system is carried out by execution of code stored in ROM (15) on data stored in RAM (14). The execution is performed under the control of CPU (13). *See, e.g.*, Fig. 3 and abstract of Byrd. An auxiliary memory circuit (3) comprises an auxiliary RAM (20), which is connected to an uninterrupted power supply. Upon detection of a failure of power, data is copied from RAM (14) into AUX RAM

(20), and the system is shut down. *See, e.g.*, Fig. 5C. Hence, Byrd's entire system can be only viewed as a single system, and not a system and a mirror-system, where in the case of a failure of one of the systems, the other system continues operating. It is well-known in the art that a mirror is generally referred to as a Web or FTP server that has the same files on it as another server. Its purpose is to provide an alternate way to access files when the main server is overloaded, thus providing an alternate way to access the data. Applicant submits that Byrd's auxiliary board (3) is not a mirror system as that term is used in the present application. Applicant further submits that the Patent Office has mischaracterized the data- and address-bus (21) synchronized by a master system clock (12) (col. 5, lines 63-65) of Byrd as a communication link. While Applicant admits that the data- and address-bus (21) is a means for transferring data under a central control, artisans more generally refer to a communication link as a physical means of connecting one location to another for the purpose of transmitting and/or receiving data. An artisan of ordinary skill would know that extending a data- and address-bus architecture, especially one that is controlled by a master clock, beyond a limited distance would be impractical at best. The AUX ROM (19) of Byrd is used such that program instructions stored in the AUX ROM (19) are executed by the CPU (13) (col. 6, lines 2-3), which is another clear indication that this AUX ROM is not used, nor intended for use, as a non-volatile memory as recited by claim 1.

Based on the foregoing reasons, Applicant submits that Byrd fails to teach or suggest all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Byrd clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicant submits that claim 1 is allowable, and further submits that claims 2-4 are allowable as

well, at least by virtue of their dependency from claim 1. Applicant respectfully requests that the Patent Office withdraw the § 102(b) rejection of claims 1-4.

4. Claims 5-74 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Byrd in view of Ofek *et al.* (U.S. Patent No. 6,052,797). Applicant traverses the rejection of claims 5-74 for at least the reasons discussed below.

The burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, as determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1208, 18 U.S.P.Q.2d 1016, 1022-23 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless of whether the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697-98 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Applicant submits that combination of Byrd and Ofek *et al.* fails to teach or suggest several features of the present invention recited in claim 1, and included in claims 5-34 via dependency. The Patent Office draws equivalence between the read-only memory (ROM) of Byrd and a non-volatile memory recited in claim 1. It is well known in the art that a ROM is programmed at manufacturing and the programming remains unchanged. Therefore, Byrd’s ROM is unable to perform the functions recited in claim 1, *i.e.*, storing data in non-volatile memory. *See, e.g.*, paragraph [0015] of the instant application.

Furthermore, according to Byrd, normal operation of the system is carried out by execution of code stored in ROM (15) on data stored in RAM (14). The execution is performed under the control of CPU (13). *See, e.g.*, Fig. 3 and abstract of Byrd. An auxiliary memory circuit (3) comprises an auxiliary RAM (20), which is connected to an uninterrupted power supply. Upon detection of a failure of power, data is copied from RAM (14) into AUX RAM (20), and the system is shut down. *See, e.g.*, Fig. 5C. Hence, Byrd's entire system can be only viewed as a single system, and not a system and a mirror-system, where in the case of a failure of one of the systems, the other system continues operating. It is well-known in the art that a mirror is generally referred to as a Web or FTP server that has the same files on it as another server. Its purpose is to provide an alternate way to access files when the main server is overloaded, thus providing an alternate way to access the data. Applicant submits that Byrd's auxiliary board (3) is not a mirror system as that term is used in the present application. Applicant further submits that the Patent Office has mischaracterized the data- and address-bus (21) synchronized by a master system clock (12) (col. 5, lines 63-65) of Byrd as a communication link. While Applicant admits that the data- and address-bus (21) is a means for transferring data under a central control, artisans more generally refer to a communication link as a physical means of connecting one location to another for the purpose of transmitting and/or receiving data. An artisan of ordinary skill would know that extending a data- and address-bus architecture, especially one that is controlled by a master clock, beyond a limited distance would be impractical at best. The AUX ROM (19) of Byrd is used such that program instructions stored in the AUX ROM (19) are

executed by the CPU (13) (col. 6, lines 2-3), which is another clear indication that this AUX ROM is not used, nor intended for use, as a non-volatile memory as recited by claim 1.

When Ofek *et al.* is combined with Byrd, the combination discloses the capability of copying from a main volatile memory to a main non-volatile memory or from a mirror volatile memory to a mirror non-volatile memory. The combination, however, lacks any teaching or suggestion of moving data from a main volatile memory to an updateable non-volatile mirror memory and vice versa, as well as management techniques thereof. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Applicant submits that one of skill in the art would not be motivated to combine the two references. Since neither reference teaches or suggests several of the advantages of the present invention as discussed above, Applicant submits that one of ordinary skill would not be motivated to combine the references. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicant submits that the combination of Byrd and Ofek *et al.* fails to teach or suggest all of the claimed elements as arranged in claim 1, and included via dependency in claims 5-34. Thus, Applicant submits that claims 5-34 are allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 5-34.



With respect to independent claim 35, Applicant submits that claim 35 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Thus, Applicant submits that claim 35 is allowable, and further submits that claims 36-41 are allowable as well, at least by virtue of their dependency from claim 35. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 35-41.

With respect to independent claim 42, Applicant submits that claim 42 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Thus, Applicant submits that claim 42 is allowable, and further submits that claims 43-50 are allowable as well, at least by virtue of their dependency from claim 42. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 42-50.

With respect to independent claim 51, Applicant submits that claim 51 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Thus, Applicant submits that claim 51 is allowable, and further submits that claims 52-62 are allowable as well, at least by virtue of their dependency from claim 51. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 51-62.

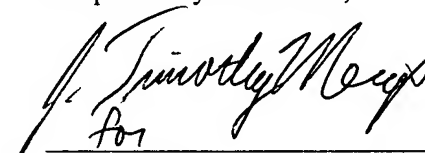
With respect to independent claim 63, Applicant submits that claim 63 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Thus, Applicant submits that claim 63 is allowable, and further submits that claims 64-74 are allowable as well, at least by virtue of their dependency from claim 63. Applicant respectfully requests that the Patent Office withdraw the § 103(a) rejection of claims 63-74.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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